

1 REMARKS

2 Status of the Claims

3 Claims 1-11 and 13-26 remain pending in the application, Claim 12 having been previously
4 canceled, Claims 1, 7, and 23 having been amended to more clearly distinguish the claimed subject
5 matter from the cited art and Claims 7 and 11 having been amended in order to provide proper
6 antecedent basis for "...the selected reference material."

7 Brief Summary of Telephone Interview

8 On September 5, 2006, during a telephone interview, applicants' attorney briefly summarized for
9 Examiner Sain, the proposed amendments and arguments to be set forth in this Office Action response.
10 Applicants' attorney appreciates Examiner Sain's willingness to discuss these proposed amendments and
11 arguments and the Examiner's willingness to consider how the amendments may distinguish over the cited
12 art when examining this formal response.

13 With respect to independent Claim 1, applicants' attorney pointed out that the proposed amendment
14 to the third step was being made to clarify a temporal element of the claim, namely, that the selected
15 reference material source was not selected until the request for information was created. Examiner Sain
16 suggested that the language be modified to recite "upon creation of the request..." to make clear the timing
17 aspect of the third step relative to a preceding step. Examiner Sain indicated it is also very helpful to ensure
18 that language is recited defining how the steps of a method claim are linked together, to avoid separate
19 references being cited to reject the steps independently of one another.

20 Applicants' attorney then pointed out that the last step recites an *automatic* comparison of the
21 information associated with the unique identifier to the string to determine whether the string should be
22 updated as opposed to manual methods utilized by a user. Examiner Sain also asked applicants' attorney to
23 provide a reference to the portion of the present application where there is a teaching of determining
24 whether the string should be updated, as recited in the last step. (The logic for this step is provided on
25 page 16, lines 4-9, and on page 15, lines 9-14 of applicants' specification.)

26 With respect to independent Claim 7, applicants' attorney pointed out how the proposed amendment
27 clarifies that the user is a *user of the selected reference material*.

28 With respect to independent Claim 11, applicants' attorney briefly summarized the arguments set
29 forth below as to why the elements cited by the Examiner in the Beauregard reference, namely, "RD" and
30 "Royal Dutch Petroleum Company" are not equivalent to applicants' "unique identifier" and "string,"

1 respectively, or in the alternative, are not equivalent to applicants' "string" and "unique identifier,"
2 respectively.

3 With respect to Independent Claim 23, applicants' attorney briefly discussed the proposed
4 amendment clarifying that the dictionary is integrated into the application program and that there are two
5 interfaces in the claimed subject matter.

6 It was also noted that Examiner Sain is invited to telephone applicants' attorney, if after his review
7 of this response, he would like to suggest any further clarifying amendments to the claims to enable the
8 claims to be allowed. Applicants' attorney would like to again thank Examiner Sain for his time and
9 willingness to discuss these issues during the telephone interview.

10 Claims Rejected under 35 U.S.C. § 102(a)

11 The Examiner has rejected Claims 1-5 under 35 U.S.C. § 102(a) as being anticipated by
12 Microsoft Corporation's Outlook 2000 electronic mail program (screen shots show version
13 9.0.0.4527, copyright 1999, hereinafter referred to as "Outlook"). Applicants respectfully disagree
14 with this rejection for the reasons discussed below.

15 Claims Rejected Under 35 U.S.C. § 102(b)

16 The Examiner has rejected Claims 7-10 as being anticipated by Gehani et al. (U.S. Patent
17 No. 5,946,687, hereinafter referred to as "Gehani").

18 The Examiner has rejected Claims 11, 15, 16, 21, and 22 as being anticipated by Beauregard.
19 Applicants respectfully disagree for the reasons noted below.

20 Claims Rejected Under 35 U.S.C. § 103(a)

21 The Examiner has rejected Claim 6 as being unpatentable over Outlook, in view of
22 Beauregard (U.S. Patent No. 5,974,413 hereinafter referred to as "Beauregard").

23 The Examiner has also rejected Claims 13, 14, 18 and 19 as being unpatentable over
24 Beauregard in view of Outlook.

25 The Examiner has rejected dependent Claim 17 over Beauregard in view of Microsoft
26 Corporation's WORD word processing program, copyright 1999 (hereinafter referred to as "MS-
27 Word").

28 The Examiner has rejected dependent Claim 20 in view of Beauregard in view of Thompson
29 (U.S. Patent Publication No. 2001/0003183, hereinafter referred to as "Thompson").
30

1 The Examiner has rejected Claims 23-24 as being unpatentable over Thompson in view of
2 Concepts' Wordworks (Non Patent Literature, copyright May 1997, hereinafter known as
3 "Wordworks") and further in view of Uyehara (U.S. Patent No. 6,154,214, hereinafter referred to as
4 "Uyehara").

5 The Examiner has rejected Claims 25-26 as being unpatentable over Thompson in view of
6 Wordworks and Uyehara, and further in view of MS-Word. Applicants respectfully disagree for the
7 reasons that follow.

8 In the interest of reducing the complexity of the issues for the Examiner to consider in this
9 response, the following discussion focuses on independent Claims 1, 7, 11, and 23. The patentability
10 of each remaining dependent claim is not necessarily separately addressed in detail. However,
11 applicants' decision not to discuss the differences between the cited art and each dependent claim
12 should not be considered as an admission that applicants concur with the Examiner's conclusion that
13 these dependent claims are not patentable over the disclosure in the cited references. Similarly,
14 applicants' decision not to discuss differences between the prior art and every claim element, or every
15 comment made by the Examiner, should not be considered as an admission that applicants concur
16 with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe
17 that all of the dependent claims patentably distinguish over the references cited. In any event, a
18 specific traverse of the rejection of each dependent claim is not required, since dependent claims are
19 patentable for at least the same reasons as the independent claims from which the dependent claims
20 ultimately depend.

21 Patentability of Claim 1

22 Significant differences exist between independent Claim 1 and Outlook because Outlook does
23 NOT teach or suggest *the temporal aspect* recited in applicants' third step of selecting a reference
24 material source based on the unique identifier and does NOT teach or suggest applicants' last step of
25 automatically comparing the information associated with the unique identifier to the string *to*
26 *determine whether the string should be updated with the information associated with the unique*
27 *identifier*.

28 It may be helpful to illustrate an exemplary application of applicants' claimed subject matter.
29 As an example of the recitation in the first step, suppose that a string (e.g., a value of a stock - see
30 applicants' specification, page 15, line 13) is identified having a unique identifier (e.g., a stock

1 symbol - *Id* at lines 10-11) associated with the string (e.g., a value of the stock). As an example of
2 the recitation in the second step, suppose that a request for information (e.g., a stock quote - *Id* at
3 lines 31-33) is created and this request for information is associated with the unique identifier (a
4 stock symbol in the example). Furthermore, assume as an example of the recitation in the third step
5 (as amended), that a reference material source (e.g., a real time stock quote source - *Id* at line 33) is
6 selected **based on the unique identifier**, wherein the reference material source includes the
7 information associated with the unique identifier (or as restated in the terms of this example, the real
8 time stock quote source includes a stock quote associated with the stock symbol). Note that this step
9 has been amended to indicate the temporal aspect of the steps, by reciting “upon creation of the
10 request, selecting a reference material source based on the unique identifier, wherein the reference
11 material source includes the information associated with the unique identifier.” This temporal
12 relationship is important because a reference material source is not selected until the request for
13 information associated with the unique identifier has been created. Support for this amendment is
14 found on page 15, lines 28-30 of applicants’ specification. At this point, as an example of the
15 recitation in the fourth step, the selected reference material source is accessed in order to obtain the
16 information associated with the unique identifier (or restating in the terms of the example, the real
17 time stock quote source is accessed in order to obtain the stock quote associated with the stock
18 symbol).

19 Then, as an example of the recitation in the last step (as amended), the information associated
20 with the unique identifier is automatically compared to the string to determine whether the string
21 should be updated with the information associated with the unique identifier (or again restating using
22 the terms of the example, the stock quote associated with the stock symbol is automatically compared
23 to the value of the stock to determine whether the value of the stock should be updated with the stock
24 quote associated with the stock symbol). Note that this step was also amended to more clearly recite
25 “...determine whether the string should be updated with the information associated with the unique
26 identifier” Support for this amendment is found on page 16, lines 4-9, because it is the
27 *application program* that determines whether the string should be updated. In addition, a portion of
28 the BACKGROUND OF THE INVENTION discloses that there is a need for recognizing that
29 information in a document has changed and for automatically updating the information (applicants’
30 specification, page 2, lines 24-26).

1 In contrast, Outlook does NOT teach or suggest applicants' third step of selecting a reference
2 material source based on a unique identifier, because Outlook does not teach *any temporal aspect*
3 relating these steps and Outlook does NOT teach or suggest applicants' last step of comparing the
4 information associated with the unique identifier to the string *to determine whether the string should*
5 *be updated* with the information associated with the unique identifier, because the determination of
6 whether any updating should be carried out in Outlook is manually done by the user and not by the
7 Outlook mail program.

8 It may also be helpful to discuss the elements in Outlook that the Examiner appears to assert
9 are equivalent to elements or steps in applicants' recited subject matter. The Examiner appears to be
10 asserting that the following elements of Outlook are equivalent to applicant's recited elements:

- 11 • Outlook's "Sain" (see box b of page 1 of Outlook; Office Action dated June 14, 2006,
12 page 3, line 1) is equivalent to applicants' *string*;
- 13 • Outlook's "Sain, Gautam," (see highlighted name in box a, *Id* at line 5) is equivalent
14 to applicants' *unique identifier*;
- 15 • Outlook's 'search for similar names as the string is typed' (*Id* at lines 10-11) is
16 equivalent to applicants' *request for information*;
- 17 • Outlook's "Global Address List" (see box c's pull down menu on Outlook page 1, *Id*
18 at page 4, lines 13-18) is equivalent to applicants' *selected reference source*;
- 19 • Outlook shows that the name sought by the author 'sain' is valid because there is an
20 entry that corresponds to that name by highlighting that entry "Sain, Gautam" (*Id* at
21 page 3, lines 19-22) which is equivalent to applicants' recitation of *determining*
22 *whether the string is valid*.

23
24 For the sake of argument, assume these elements in Outlook are equivalent to applicants'
25 claimed elements, in accord with the following example. As an example of the recitation in the first
26 step, a string (e.g., "Sain") is identified having a unique identifier (e.g., "Sain, Gautam,") associated
27 with the string. As an example of the recitation in the second step, a request for information (e.g., a
28 search for similar names as the string is typed) is created, and this request for information (e.g.,
29 search for similar names as the string is typed) is associated with the unique identifier (e.g., "Sain,
30 Gautam"). Furthermore, as an example of the recitation in the third step (as amended), a reference

1 material source (e.g., “Global Address list”) is selected, and the reference material source (i.e., the
2 Global Address List in this example) contains the information (i.e., the search for similar names as
3 the string is typed – in this example) associated with the unique identifier (i.e., “Sain, Gautam” in this
4 example). However, it appears from page 1 of Outlook that the reference material source (i.e.,
5 the Global Address List) must be selected *prior* to the step of identifying a string and prior to the
6 second step of creating a request for information, and the selection of the reference material source is
7 done by default by Outlook or by the user. Otherwise, as a user types “Sain” there can be no search
8 by the Outlook program for similar names.

9 Continuing on, as an example of the recitation in the fourth step, the selected reference
10 material source (i.e., the “Global Address List” in this example) is accessed in order to obtain the
11 information (i.e., the search for similar names as the string is typed) associated with the unique
12 identifier (i.e., “Sain, Gautam” in this example). Then, as an example of the recitation in the last step
13 (as amended), the information (i.e., search for similar names as the string is typed) associated with
14 the unique identifier (i.e., “Sain, Gautam” in this example) is automatically compared to the string
15 (i.e., “Sain” in this example) to determine whether the string should be updated with the information
16 (i.e., a search for similar names as the string is typed) associated with the unique identifier (i.e.,
17 “Sain, Gautam” in this example). However, Outlook does not make or suggest making any
18 determination regarding updating the string “Sain.” A user who decides to type additional characters
19 can manually make a comparison to determine whether the string should be updated, but this step is
20 not carried out by the Outlook software.

21 Accordingly, since the cited art neither teaches nor suggests all of the recitation of
22 independent Claim 1, the rejection of independent Claim 1 under 35 U.S.C. § 102(a) should be
23 withdrawn.

24 Because dependent claims include all of the elements of the independent claim from which
25 the dependent claims ultimately depend, dependent Claims 2-6 are patentable for at least the reasons
26 discussed above in regard to independent Claim 1. Accordingly, the rejection of dependent Claims 2-
27 5 under 35 U.S.C. § 102(a) and the rejection of dependent Claim 6 under 35 U.S.C. § 103(a) should
28 be withdrawn.
29
30

1 Patentability of Claim 7

2 Significant differences also exist between independent Claim 7 and the cited art, because the
3 cited art does not teach or suggest that an identity of a user *of the selected reference material* is
4 relevant. As amended, applicants' second step recites:

5
6 determining that an identity of a *user of the selected reference material* is relevant to
7 the selected reference material and if so ... (Emphasis added)

8
9 For example, the user may request selected reference material such as a set of directions to a
10 place (applicants' specification, page 16, lines 15-16) and therefore, the set of directions should begin
11 from the user's current location (*Id* at lines 16-17). Thus, as clarified in the amended step above, it is
12 determined that an identity of the user of the selected reference material (e.g., the set of directions) is
13 relevant.

14 The Examiner interprets Gehani's teaching of a contact name or similar record identifier as
15 equivalent to the identity of a user because it is meant to convey personal information about a user or
16 person, to provide requested information that is relevant to a user (Office Action, page 21).
17 Accordingly, applicants have amended this step to recite that the identity of a user pertains to *a user*
18 *of the selected reference material*, thus clarifying, for the example noted above, that the user is a user
19 of the set of directions. In other words, the claim now makes it clear that the selected reference
20 material must be relevant to the person making a request and not just to some arbitrary user.
21 Accordingly, the rejection of independent Claim 7 under 35 U.S.C. § 102(b) should be withdrawn
22 because the cited art fails to teach or suggest all of the claim recitation components of independent
23 Claim 7.

24 Because dependent claims include all of the elements of the independent claim from which
25 the dependent claims ultimately depend, dependent Claims 8-10 are patentable for at least the reasons
26 discussed above in regard to independent Claim 7. Accordingly, the rejection of dependent Claims 8-
27 10 under 35 U.S.C. § 102(b) should be withdrawn.

28 Patentability of Claim 11

29 Significant differences exist between independent Claim 11 and the cited art because the cited
30 art does NOT teach or suggest both: (1) an electronic document comprising a string having a unique
identifier associated with the string; AND, (2) that the request for information comprises the unique

1 identifier. It may be helpful to discuss an example of a couple of the steps in this claim. As an
2 example of the first portion of the recitation in the first step, suppose that the system includes an
3 application program (e.g., an electronic mail application program - see applicants' specification,
4 page 14, lines 9-10) for creating an electronic document (e.g., e-mail; *Id*) and for creating a request
5 for information (e.g., a request to determine if the address of a person associated with a proper name
6 is included in the user's address book - *Id* at lines 13-14). Further, as an illustration of the second
7 portion, suppose that the electronic document (e.g., an e-mail) comprises a string (e.g., a proper name
8 - *Id* at line 11) having a unique identifier (e.g., a name label - *Id* at lines 12-13) associated with the
9 string (e.g., the proper name), wherein the request for information comprises the unique identifier
10 (e.g., the name label).

11 As an example of the recitation in the second step, suppose that the system also includes a
12 reference engine for receiving the request for information from the application program, selecting one
13 of a plurality of reference material sources (e.g., the address book) based upon the request for
14 information, and accessing (e.g., as noted in step 608 of FIGURE 6) the selected reference material
15 source (e.g., the address book associated with electronic mail application program - *Id* at lines 8-9) to
16 obtain the selected reference material (e.g., the address);

17 In contrast, Beauregard does NOT teach or suggest both: (1) an electronic document
18 comprising a string having a unique identifier associated with the string; and, (2) the request for
19 information comprising the unique identifier. Beauregard instead teaches at most, one of these two
20 claim recitations, but not both. It appears that the Examiner is asserting that the following elements
21 of Beauregard are equivalent to applicant's recited elements:

- 22 • Beauregard's "e-mail message" (Office Action dated June 14, 2006, page 8, lines 11-
23 12) is equivalent to applicants' *electronic document*;
- 24 • Beauregard's "subscription service;" (*Id* at lines 15-16) is equivalent to applicants'
25 *reference material source*;
- 26 • Beauregard's "RD" (*Id* at lines 17-19) is equivalent to applicants' *unique identifier*;
- 27 • Beauregard's "Royal Dutch Petroleum Company" (*Id*) is equivalent to applicants'
28 *string*;
- 29
- 30

- Beauregard's "typing the short symbol identifier so that it is replaced with the full name of the company" (Id at lines 19-20) as equivalent to applicants' *request for information*.

For the sake of argument, again assume these elements to be equivalent to applicants' claimed elements, in accord with the following example. Suppose that the system includes an application program for creating the electronic document (i.e., an e-mail message in this example) and creating a request for information (e.g., a request to replace short symbol identifier with full company name) to obtain selected reference material (e.g., to obtain a full company name from a subscription service). Furthermore, in regard to the second portion of the claim, suppose the electronic document (e.g., the e-mail message) comprises a string (e.g., "Royal Dutch Petroleum Company") having a unique identifier (e.g., "RD") associated with the string, and that the request for information (e.g., the request to replace short symbol identifier with the full company name) comprises the unique identifier (e.g., RD). The claim recites that the electronic document comprises a string, but in Beauregard, in the electronic document, i.e., in the e-mail message, the e-mail message does not include the string "Royal Dutch Petroleum Company," but instead includes only the unique identifier "RD" (Beauregard, column 52, line 19). The full name is sought in the subscription service but what is typed by the user in the e-mail message is initially "RD," although "RD" is eventually replaced by the full name.

In the alternative, assume Beauregard's "RD" is equivalent to applicants' string and that Beauregard's "Royal Dutch Petroleum Company" is equivalent to applicants' unique identifier. Then in regard to the second portion of the claim, suppose that the electronic document (e.g., the e-mail message) comprises a string (e.g., "RD") having a unique identifier (e.g., "Royal Dutch Petroleum Company") associated with the string and that the request for information (e.g., the request to replace the short symbol identifier with the full company name) comprises the unique identifier (e.g., Royal Dutch Petroleum Company). But then why would there be a request for information involving replacing the short symbol identifier with the full company name since the request for information already includes the unique identifier (e.g., the full name of "Royal Dutch Petroleum Company")? Thus, for this example, the request for the selected reference material would not need to be made.

Accordingly, the rejection of independent Claim 11 under 35 U.S.C. § 103(a) should be withdrawn. Because dependent claims include all of the elements of the independent claim from which the dependent claims ultimately depend, dependent Claims 13-22 are patentable for at least the reasons discussed above in regard to independent Claim 11. Accordingly, the rejection of dependent Claims 15-16, and 21-22 under 35 U.S.C. § 102(b) and the rejection of dependent Claims 13, 14, 17-18 and 19-20 under 35 U.S.C. § 103(a) should be withdrawn.

Patentability of Claim 23

Significant differences exist between independent Claim 23 and the cited art because the cited art does not teach or suggest integrating a dictionary into an application program and does not teach or suggest both a user interface and a dictionary interface.

Applicants' first step in Claim 23 (as amended) recites:

integrating a dictionary into an application program such that in response to a selection of a dictionary control provided in the user interface of the application program, displaying a dictionary interface on a display device

Under the section entitled "Response to Arguments," the Examiner has disagreed that the cited references of Thompson in view of Wordworks and Uyehara do not teach "in response to a selection of a dictionary control provided in the user interface of the application program, displaying a dictionary interface on a display device" (Office Action, page 22). The Examiner cites page 2 of WordWorks and indicates that it teaches a user interface where the user enters a word and selects the control button "Lookup" to look up the word in the dictionary. In response to lookup control being selected, the lower part of the user interface shows the dictionary/thesaurus entry as it appears in the user interface.

Applicants have amended Claim 23 to clarify that the dictionary tool is *integrated* into the application program, which is disclosed in applicants' specification at page 11, lines 10-11. In contrast, Page 1 of Wordworks states:

This stand-alone application works with all word processors (although it is more integrated with Impressions) and is the ideal assistant for all word processor users.

Although the above citation states that Wordworks is "more integrated with Impression," there are no additional details provided and Wordworks still teaches that it is a *stand-alone*

1 application as opposed to applicants' recitation in this claim that the dictionary is not a stand-alone
2 application, but instead, is integrated into the application program.

3 Applicants also respectfully point out that there are two interfaces recited in Claim 23, a user
4 interface and a dictionary interface. Yet, it appears from page 2 of Woodworks that only one
5 interface exists in the cited art.

6 Accordingly, the rejection of independent Claim 23 under 35 U.S.C. § 103(a) should be
7 withdrawn. Because dependent claims include all of the elements of the independent claim from
8 which the dependent claims ultimately depend, dependent Claims 24-26 are patentable for at least the
9 reasons discussed above in regard to independent Claim 23, and the rejection of dependent
10 Claims 24-26 under 35 U.S.C. § 103(a) should be withdrawn.

11 In view of the amendments and Remarks set forth above, it will be apparent that all pending
12 claims in this application define a novel and non-obvious invention, and that the application is in
13 condition for allowance and should be passed to issue without further delay. Should any further
14 questions remain, the Examiner is invited to telephone applicants' attorney at the number listed
15 below.

16 Respectfully submitted,

17
18 /sabrina k. macintyre/
19 Sabrina K. MacIntyre
20 Registration No. 56,912

21 SKM/RMA:elm
22
23
24
25
26
27
28
29
30